

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket No.: 14364US10

In The Application Of:)	
Kubler, <i>et al.</i>)	
Serial No.:)	
10/760,322)	
Filed:)	
January 16, 2004)	
For:)	
HIERARCHICAL DATA)	
COLLECTION NETWORK)	
SUPPORTING PACKETIZED)	Filed electronically on
VOICE COMMUNICATIONS)	
AMONG WIRELESS TERMINALS)	February 9, 2010.
AND TELEPHONES)	
Examiner: WANG, DAVID)	
Group Art Unit:)	
2617)	
Confirmation No.:)	
2925)	

REQUEST FOR WITHDRAWAL OF FINALITY PURSUANT TO MPEP §706.07(d)

Mail Stop: AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Examiner Wang:

Applicants are in receipt of a final Office Action mailed January 4, 2011 (the "Final OA"), in the above-identified application (the "Application"). Applicants respectfully submit that the finality of the subject Office Action is premature and therefore requests withdrawal of that finality, pursuant to Section 706.07(d) of the Manual of Patent Examining Procedure (MPEP).

Grounds:

As grounds for this Request, Applicants state as follows:

1. Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office action is proper, providing that:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement....

2. Section 706.07(d) of the MPEP provides a remedy when a final Office Action is issued and the conditions of MPEP § 706.07(a) have not been satisfied. Specifically, MPEP 706.07(d), entitled "Final Rejection, Withdrawal of, Premature," provides:

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. The finality of the Office action must be withdrawn while the application is still pending. The examiner cannot withdraw the final rejection once the application is abandoned.

3. The final Office Action rejects independent claim 22, 45, and 54 on new grounds. As the Office itself states, "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action." (See Final OA, Point 61, Page 25). As shown below, the Applicants respectfully submit that the final Office Action introduced new grounds for rejection that were not necessitated by Applicants' amendments or a filing of an Information Disclosure Statement.

4. In Points 7-8 of the Final OA, claims 22, 45, and 54 were rejected under 35 U.S.C. § 103(a). Specifically, the Final OA rejects claims 22, 45, and 54 over a proposed combination of US 5,737,331 ("Hoppal") in view of US 5,148,429 ("Kudo"), US 5,742,640 ("Haoui"), and Newton's Telecom Dictionary (8th Edition, 1994). (See Final OA, Point 7, Page 4). The Applicants note that the non-final Office Action mailed April 26, 2010 rejected Applicants' independent claims 22, 45, and 54 under 35 U.S.C. §103(a) in view of Hoppal and Kudo. The Applicants respectfully note that Applicants' amendment to independent claim 22 in the response filed August 6, 2010 merely added features of dependent claim 80 (*i.e.*, "wherein the outgoing digital voice data is transmitted redundantly over the wireless packet network") to independent claim 22. Similarly, Applicants' amendments to independent claims 45 and 54 merely added features of claim 82 (*i.e.*, "wherein the first digital representation of sound is transmitted redundantly over the wireless packet network") to independent claim 45, and features of dependent claim 84 (*i.e.*, "wherein the outgoing digital voice data is transmitted redundantly over the wireless packet network") to claim 54. The Applicants respectfully submit that these amendments to claims 22, 45, and 54 merely brought features of dependent claims 80, 82, and 84 into their respective independent claims, and did not add new matter that would necessitate introduction of new art. Applicants respectfully note that the Office Action of April 26, 2010 rejected the features of dependent claims 80, 82, and 84 under 35 U.S.C. §103(a) in view of only Hoppal, Kudo, and Haoui. (See April 26, 2010 Office action, Point 39, Page 15) Applicants respectfully submit that claims 80, 82, and 84 depend, respectively, from independent claims 22, 45, and 54 and, therefore, inherently include all the limitations of their respective parent claims, the same limitations now recited by independent claims 22, 45, and 54. Therefore, amending claims 22, 45, and 54 to include the language of dependent claims 80, 82, and 84, respectively, did not add new matter. Indeed, independent claims 22, 45, and 54 now recite the same limitations previously recited by dependent claims 80, 82, and 84. The Office, however, now rejects claims 22, 45, and 54 over Hoppal, Kudo, Haoui **and** Newton's Telecom Dictionary (8th Edition, 1994). In other words, the Applicants' amendments to independent claims 22, 45, and 54 did not necessitate the final Office

Action's new ground for rejection under 35 U.S.C. § 103(a) in view of Hoppal, Kudo, Haoui **and** Newton's Telecom Dictionary (8th Edition, 1994). Thus, because the final Office Action's new grounds for rejecting Applicants' independent claims 22, 45, and 54 was not necessitated by Applicants' amendment of claims 22, 45, and 54, or an Information Disclosure Statement, the Applicants respectfully requests that the finality of the present Office Action be withdrawn.

5. Applicants' dependent claims 41 and 70 were previously rejected in the non-final Office Action mailed April 26, 2010 under 35 U.S.C. § 103(a) at being unpatentable over Hoppal in view of Kudo, as applied to claims 22 and 54, and further in view of US 5,596,573 ("Bertland"). (See April 26, 2010 Office action, Points 6 and 11, Pages 5-6) The final Office Action, however, sets forth a **new rejection** of Applicants' dependent claims 41 and 70 as being unpatentable over Hoppal in view of Kudo, Haoui, and Newton's Telecom Dictionary (8th Edition, 1994), as applied to claims 22 and 54, **and further in view of US 4,376,874 ("Karban")**. (See Final OA, Points 16-17, page 9) The Applicants respectfully note that **Applicants' dependent claims 41 and 70 were not amended**. Thus, because the final Office Action's new grounds for rejecting Applicants' dependent claims 41 and 70 were not necessitated by an amendment or an Information Disclosure Statement, the Applicants respectfully request that the finality of the present Office Action be withdrawn.

6. The Applicants respectfully submit that the new grounds of rejection of independent claims 22, 45, and 54 and dependent claims 41 and 70 in the final Office Action cannot reasonably be said to be either necessitated by a claim amendment or an Information Disclosure Statement. Therefore, the Applicants respectfully request that the finality of the final Office Action be withdrawn.

Appln. No. 10/760,322
Filed: January 16, 2004
Resp. to final Office Action mailed January 4, 2011
Req. to Withdrawal Finality dated February 9, 2011

Conclusion

The conditions set forth in § 706.07(a) of the MPEP have not been satisfied. Accordingly, for that reason alone, as well as the interests of fairness, the Applicants respectfully request that the finality of the final Office Action be withdrawn.

The Commissioner is hereby authorized to charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 130017.

Dated: February 9, 2011

Respectfully submitted,

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